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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/835,292

04/13/2001

James F. Bredt

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10/28/2004

TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON, MA 02110

EXAMINER

THEXTON, MATTHEW

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,292

Applicant(s)

BREDET ET AL.

Examiner

Matthew A. Thexton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21, 23, 26, 30-32 and 42-68 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 12-18, 42, 43, 48 and 62-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-19, 21, 23, 26, 30-32 and 42-68 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date two sheets.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 4,5,8-11,19,21,23,26,30-32,41,44-47,49-61 and 65-68.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of ethyl acetate in the reply filed on 2004 September 29 is acknowledged.

Claims 4, 5, 8-11, 19, 21, 23, 26, 30-32, 41, 44-47, 49-61, and 65-68 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2004 September 29.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Status of Claims

Claims 1-19, 21, 23, 26, 30-32, and 42-68 are pending.

Claims 20, 22, 24, 25, 27-29, and 33-40 are canceled.

Claims 1-3, 6, 7, 12-18, 42, 43, 48, and 62-64 read on the elected specie.

Claims 4, 5, 8-11, 19, 21, 23, 26, 30-32, 41, 44-47, 49-61, and 65-68 are withdrawn as being drawn to a nonelected invention.

This status of claims does not agree with Applicant's statement on page 11 of response filed 2004 October 15. Applicant has listed claims as reading on the elected specie claims which further comprise a solvent or adhesive or component which may be

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found in the list of species in the restriction requirement mailed 2004 May 27. That requirement stated, in part, "If the elected invention is intended to require the presence of water, 'a fluid,' or any other component, Applicant is required to so state. An election of a compound or polymer will be examined as such." At page 9 of the response filed on 2004 September 29, Applicant stated, in part, "Applicants note that no other component, e.g., a water or a fluid, is required by this elected invention." Therefore, claims, such as claim 19, which require two or more species have not been elected. Applicant was not prohibited from electing a combination of species; such was specifically invited in the restriction requirement mailed 2004 May 27 in which the species list concluded with "and disclosed combinations of these species."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 7, 12-18, 42, 43, 48, and 62-64 are rejected under 35 U.S.C. 102(b) as being anticipated by "Hackh's Chemical Dictionary," page 250, "ethyl acetate."

Independent claims 1 and 62, as elected, require a composition comprising ethyl acetate "adapted to be deposited using an electromechanical printhead to selectively adhere particulate material to form a solid object in a three-dimensional printer."

Applicant may not now assert that the claims require an additional component to accomplish "adapted to be deposited using an electromechanical printhead to selectively adhere particulate material to form a solid object in a three-dimensional printer" because, as noted above, Applicant explicitly disavowed the presence of other components in the election.

Ethyl acetate is known. It appears from Applicant's disclosure that ethyl acetate may inherently have the required properties "to selectively adhere particulate material to form a solid object in a three-dimensional printer" (e.g., page 6, lines 1-10, page 7, lines 14-15, page 21, lines 9-18); ethyl acetate may be a "monomeric organic compound" which may be an adhesive. Discovery of new uses or properties of old compound(s) does not lend patentability to the old compound(s).

Dependent claims 12, 42, and 43 which further characterizes the ethyl acetate as "curable by ultraviolet radiation, in combination with a photoinitiator, to form a solid," is either describing an inherent property, or the claim does not encompass the elected specie. In the latter case, these claims will be withdrawn.

Dependent claims 13-18, 48 which further characterize the particulate material do not positively recite the presence of the particulate in the composition, therefore the ethyl acetate per se is encompassed by the claims.

Dependent claims 63 and 64 which further characterize the group of solvents do not positively require the sub-genus (group) in the composition, therefore the ethyl acetate per se is encompassed by the claims.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew A. Thexton whose telephone number is 571-272-1125. The examiner can normally be reached on Monday-Friday, 9:30 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasudevan S. Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. A. Thexton

Matthew A. Thexton
Primary Examiner
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